

Remarks

Independent claims 1, 9, 17 and 26 have been amended to indicate that the table contains permissible combinations of voltage and frequency. Support for this limitation may be found in the specification in the first sentence of the Detailed Description of the Invention.

Claims 1, 4-6, 9 and 12-14 have been rejected under 35 USC 102(b) as being anticipated by U.S. patent no. 6,311,287 ("Dischler").

Claims 2, 3, 7, 8, 10, 11 and 15-29 have been rejected under 35 USC 103(a) as being unpatentable over Dischler and U.S. patent no. 6,425,086 ("Clark").

Applicants respectfully traverse these rejections because the cited references do not disclose or suggest every element of any claim, as the following analysis shows.

Independent claims 1, 9, and 17 each recite a register to select an entry in a table, the entry containing voltage and frequency fields, while independent claim 26 recites instructions that cause writing to such a register. Dischler does not disclose these limitations. The rejection indicates that Dischler teaches the table in Fig. 7 and col. 7 lines 60-65, and teaches the register in Figs. 1, 2, 5B, and col. 6 lines 12-19 and col. 7 lines 18-24. However, the only register referred to in these sections is register 31 (Fig. 2 and col. 5 line 8) which is not tied to the table of Fig. 7 in any way. The text at col. 7 lines 18-24 only refers to a frequency table, which Dischler explicitly states on line 21 is not shown in the Figures and is therefore not the table of Fig. 7. The referenced parts of Dischler only show the existence of a table and the existence of a register, but do not disclose or suggest that a field of that register is used to select an entry from that table.

Therefore a rejection under 35 USC 102 is inappropriate for the rejection of claims 1 and 9. Further, a rejection of claims 17 and 26 under 35 USC 103 is inappropriate because the cited references do not disclose a motivation for combining a table and a register in the claimed manner.

Applicant respectfully asserts that the rejection fails to establish a *prima facie* case of obviousness under 35 CFR 103 and, therefore, the relevant claims are in a condition for allowance. Section 2143 of the Manual of Patent Examining Procedure (“MPEP”) sets forth the requirements that must be satisfied to establish a *prima facie* case of obviousness under 35 USC 103. Section 2143 requires the cited references to contain a suggestion or motivation to combine them. The rejection fails to make this showing because it does not point out a suggestion or motivation to combine from within the references. Instead, it only makes a conclusory statement that it would have been obvious to one of ordinary skill in the art to combine the unrelated table and register of Dischler because that would have a beneficial result. If beneficial results were a sufficient basis for obviousness, few patents would ever be granted because most patented inventions provide a beneficial results. Further, the possibility that a person of ordinary skill in the art might envision such a benefit likewise does not provide the motivation to combine. This reasoning engages in hindsight speculation that section 2143 and the Federal Circuit expressly proscribe: “the level of skill in the art cannot be relied upon to provide the suggestion to combine references,” (MPEP 2143, citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999)).

It is noteworthy that section 2143 takes pains to make this point clear, elaborating that “a statement that modifications of the prior art to meet the claimed invention would

have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness with some objective reason to combine the teachings of the references." (citing *Ex parte Levengood*, 28 USPQ2d 1300, Bd. Pat. App. & Inter. 1993). By repeating the mistakes criticized in section 2143 and failing to show a suggestion or motivation to combine the cited references, the rejection has failed to establish a prima facie case of obviousness under 35 USC 103.

The remaining pending claims depend from claims 1, 9, 17 and 26, and therefore also contain the limitations that are not disclosed or suggested by the cited references.

Conclusion

For the foregoing reasons, it is submitted that the application is in condition for allowance, and indication of allowance by the Examiner is respectfully requested. If the Examiner has any questions concerning this application, he or she is requested to telephone the undersigned at the telephone number shown below as soon as possible. If any fee insufficiency or overpayment is found, please charge any insufficiency or credit any overpayment to Deposit Account No. 02-2666.

Respectfully submitted,

Intel Corporation

Date: 1-12-04

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